

REMARKS

This is in full and timely response to the final Office Action mailed October 20, 2003. Entry of this Amendment is proper under 37 C.F.R. §1.116 since the amendment: (a) places the application in condition for allowance (for the reasons discussed herein); (b) does not raise any new issues requiring further search and/or consideration; (c) satisfies a requirement of form asserted in the previous Office Action; and (d) places the application in better form for appeal, should an appeal be necessary. The amendment is necessary and was not earlier presented because it is made to incorporate an additional element in response to the new §112 rejection noted in the Office Action. Entry of this amendment is respectfully requested. Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

By the foregoing amendment, claim 7 was amended to recite the step of preparing a magnetic layer coating material by dispersing a magnetic layer coating composition containing a magnetic powder, a binder and an organic solvent. Support for this amendment can be found variously throughout the specification, or example, original claim 10. Support for new claim 20 can be found variously throughout the specification, for example, at page 16, lines 19-20, page 19, lines 16-18 and page 29, lines 18-20. No new matter was added. Claims 7-9 and 16-23 are currently pending for the Examiner's reconsideration, with claims 7 and 16 being independent.

Rejections under 35 U.S.C. §112

Claims 7-9, 22 and 23 were rejected under 35 U.S.C. §112, second paragraph for indefiniteness. By this Amendment, claim 7 was amended to recite the step of preparing a magnetic layer coating material by dispersing a magnetic layer coating composition containing a magnetic powder, a binder and an organic solvent prior to the step of dispersing the magnetic layer coating material again by means of an online dispersion apparatus, mooting this rejection.

Withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. §103

Claims 7-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,153,295 to Nishizawa et al. in view of U.S. Patent No. 5,433,973 to Wallack et al. and U.S. Patent No. 5,382,687 to Morishita et al. allegedly "for the same reasons as urged in the action of

3-19-03. The limitations of dependent claims 19-23 are considered conventional and do not render these claims unobvious.” See Office Action at page 2, lines 8-11. Applicant respectfully traverses this rejection.

Applicant notes the following regarding this rejection:

1. The previous Office Action (Paper No. 19) did not reject at least independent claim 16 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,153,295 to Nishizawa et al. in view of U.S. Patent No. 5,433,973 to Wallack et al. and U.S. Patent No. 5,382,687 to Morishita et al. Accordingly, this rejection is improper because it refers to a previous rejection that is not of record.
2. The examiner has not mapped the claim elements to the applied references, rather, has made an omnibus rejection that is to be avoided as non-informative. See MPEP §707.07(d) which states

IMPROPERLY EXPRESSED REJECTIONS

An omnibus rejection of the claim “on the references and for the reasons of record ” is stereotyped and usually not informative and should therefore be avoided. This is especially true where certain claims have been rejected on one ground and other claims on another ground.

Accordingly, this rejection is improper, and the finality of this Office Action should be withdrawn.

3. The examiner has not answered all material traversed. MPEP §707.07(f) recites (emphasis added):

**707.07(f) Answer All Material Traversed
[R-1]**

>In order to provide a complete application file history and to enhance the clarity of the prosecution history record, **an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.**<

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the

substance of it.

>If applicant's arguments are persuasive and upon reconsideration of the rejection, the examiner determines that the previous rejection should be withdrawn, the examiner must provide in the next Office communication the reasons why the previous rejection is withdrawn by referring specifically to the page(s) and line(s) of applicant's remarks which form the basis for withdrawing the rejection. It is not acceptable for the examiner to merely indicate that all of applicant's remarks form the basis for withdrawing the previous rejection. Form paragraph 7.38.01 may be used. If the withdrawal of the previous rejection results in the allowance of the claims, the reasons, which form the basis for the withdrawal of the previous rejection, may be included in a reasons for allowance. See MPEP § 1302.14..

If applicant's arguments are persuasive and the examiner determines that the previous rejection should be withdrawn but that, upon further consideration, a new ground of rejection should be made, form paragraph 7.38.02 may be used. See MPEP § 706.07(a) to determine whether the Office action may be made final.<

If a rejection of record is to be applied to a new or amended claim, specific identification of that ground of rejection, as by citation of the paragraph in the former Office letter in which the rejection was originally stated, should be given.

ANSWERING ASSERTED ADVANTAGES

After an Office Action, the reply (in addition to making amendments, etc.) may frequently include arguments and affidavits to the effect that the prior art cited by the examiner does not teach how to obtain or does not inherently yield one or more advantages (new or improved results, functions or effects), which advantages are urged to warrant issue of a patent on the allegedly novel subject matter claimed.

If it is the examiner's considered opinion that the asserted advantages are not sufficient to overcome the rejection(s) of record, he or she should state the reasons for his or her position in the record, preferably in the action following the assertion or argument relative to such advantages. By so doing the applicant will know that the asserted advantages have actually been considered by the examiner and, if appeal is taken, the Board of Patent Appeals and Interferences will also be advised. See MPEP § 716 *et seq.* for the treatment of affidavits and declarations under 37 CFR 1.132.

The importance of answering applicant's arguments is illustrated by *In re Herrmann*, 261 F.2d 598, 120 USPQ 182 (CCPA 1958) where the applicant urged that the subject matter claimed produced new and use-

ful results. The court noted that since applicant's statement of advantages was not questioned by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable. See also *In re Soni*, 54 F.3d 746,751,34 USPQ2d 1684,1688 (Fed. Cir.1995)(Office failed to rebut applicant's argument).

Thus, it is well settled that failure to rebut Applicant's arguments is de facto acceptance of the statements at face value. Since Applicant's arguments have not been addressed in the final Office Action, this rejection is improper, and the claims are in condition for allowance.

Additionally, as the examiner has only **vaguely** allegedly reiterated the rejection from the previous Office Action, and has not addressed any of the arguments raised by the Applicant in the previous Amendment, the examiner by default admits that the references do not disclose, teach or suggest all of the elements contained in the claims, and that the rejection is not recited with specificity, as discussed above. Accordingly, the examiner has effectively withdrawn the rejection, and the examiner is requested to acknowledge this withdraw the rejection. See *In re Soni*, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed. Cir. 1995) (Office failed to rebut applicant's argument). See also MPEP §707.07(f).

At least for the reasons above,

1. this rejection is improper, and the finality of this Office Action should be withdrawn, and
2. Applicant's previous arguments are un rebutted and therefore de facto accepted at face value, and the claims are allowable over the applied art.

For completeness, Applicant repeats below the arguments presented in the previous Amendment:

Claim 7 recites a process for producing a magnetic recording medium which comprises: applying a non-magnetic layer coating material onto a non-magnetic support; drying the coating material to form a non-magnetic layer; curing the non-magnetic layer after drying the non-magnetic layer coating material; preparing a magnetic layer coating material by dispersing a magnetic layer coating composition containing a magnetic powder, a binder and an organic solvent; dispersing the magnetic layer coating material again by means of an online dispersion

apparatus; and immediately applying the magnetic layer coating material more excessively than an intended magnetic layer-wet thickness onto the non-magnetic layer by using a die nozzle coating followed by scraping excess amounts of the magnetic layer coating material to the intended magnetic layer-wet thickness by means of a bar to form a magnetic coating layer.

Claim 16 recites a process for producing a magnetic recording medium, which comprises: applying a non-magnetic layer coating material onto a non-magnetic support; drying the coating material to form a non-magnetic layer; radiation-curing the non-magnetic layer after drying the non-magnetic layer coating material; and applying a magnetic layer coating material more excessively than an intended magnetic layer-wet thickness onto the non-magnetic layer by using a die nozzle coating followed by scraping excess amounts of the magnetic layer coating material to the intended magnetic layer-wet thickness by means of a bar to form a magnetic coating layer.

Nishizawa et al. '295 discloses a method of making a magnetic recording medium comprising applying an undercoating on a substrate, drying and curing the undercoating and applying a magnetic coating to the undercoating. As acknowledged in the Office Action, Nishizawa et al. '295 fail to explicitly disclose, teach or suggest radiation curing.

Wallack et al. '973 teach radiation curing a coating after it has been dried, however this curing process is only performed on a "backside or magnetic side dispersion" (col. 5, lines 40-65). In contrast, claim 16 of the present application clearly requires the radiation curing be performed on the non-magnetic layer, disposed between the magnetic layer and non-magnetic support, and claim 7 clearly requires that the curing be performed on the non-magnetic layer, disposed between the magnetic layer and non-magnetic support, . While Wallack et al. '973 states that the pigment used in the coating material to be radiation-cured "can be either magnetic or non-magnetic" (col. 4, lines 26-36), further inspection reveals the non-magnetic pigment described here is only for use in the backside coating, which is applied on the opposite surface of the substrate as that of the magnetic layer. (col. 5, lines 40-54). Clearly, the chemical properties, dimensions and weight requirements of the back-coat layer and non-magnetic underlayer widely differ (pages 6-16 and 20-22), as do their objectives (pages 5 and 20). Therefore, because Wallack et al. '973 fail to disclose, teach or suggest radiation curing or curing of a "non-magnetic layer" disposed between the magnetic layer and the non-magnetic support as is claim in the present application, the Examiner has failed to make a *prima facie* case of obviousness with respect to claims 7 and 16.

As amended, claim 7 was combined with the elements of claim 4. Accordingly, in order to advance prosecution, as the examiner previously rejected claim 4 as alleging that the “limitations of these dependent claims are conventional and do not render these claims obvious. See Morishita et al...,” Applicant will address the elements of claim 4 combined with claim 7.

The process described in U.S. Patent No. 5,382,687 to Morishita et al. (Morishita et al. ‘687) relates to a technology group entirely different from that in the present application. As such, Morishita et al. ‘687 fail to appreciate the importance of producing a magnetic recording medium possessing the requisite electromagnetic characteristics necessary for effective magnetic recording mediums. The process disclosed in Morishita et al. ‘687 is concerned solely with the achievement of “electrophotographic properties” (col. 1, lines 13-31), not electromagnetic characteristics. As stated on page 2 of the specification, one of the primary goals of the present invention is achieving a magnetic layer having a sufficient sensitivity suited for use in an MR head. In order to be suited for use by an MR head, various electromagnetic characteristics must be attained, such as, for example, a S/N ratio of 20 dB or greater (page 36), a magnetic layer consisting of at least 50% magnetic powder (page 17) or a surface roughness of 5nm or less (page 20). Morishita et al. ‘687 fail to disclose, teach or suggest fulfilling any of these electromagnetic requirements because it is concerned solely with electrophotographic properties. There is therefore no guarantee or certainty that the product produced in Morishita et al. ‘687 would attain the electromagnetic characteristics necessary for suitable use in an MR head. Consequently, one skilled in the art would lack the requisite motivation to combine the teachings of Morishita et al. ‘687 with Nishizawa et al. ‘295 in order to reach the claims of the present application.

As described in the present application, because the magnetic coating tends to form an extremely dilute solution, flocculation, or lumping of the coating, tends to occur. This flocculation may be prevented by dispersing the magnetic coating again by online dispersion immediately before applying the coating material onto the non-magnetic layer. See page 24. More specifically, it is suggested an ultrasonic dispersion apparatus is preferably used for this process. Morishita et al. ‘687, however, fail to appreciate the problem of flocculation, nor does it suggest that by subjecting the coating to an additional online dispersion process the problem will be remedied. The above discussions regarding the divergent technologies of the present invention and Morishita et al. ‘687 clearly show why a person of ordinary skill in the art would

not reach the invention of claim 4 by combining the teachings of Morishita et al. '687 and Nishizawa et al. '295, or Morishita et al. '687, Nishizawa et al. '295 and Wallack et al. '973.

Moreover, the charge generation layer cited in Morishita et al. '687 is a photoconductive layer, not a magnetic layer. The magnetic layer of the present invention consists of at least 50% by weight of magnetic powder, and more preferably 55 to 75%. See page 17. The charge generation layer described in Morishita et al. '687, however, fail to disclose, teach or suggest the use of any amount of magnetic powder at all. As described in column 26, lines 53-68, the charge generation material of Morishita et al. '687 consists of various metals, non-metals or pigments; none of which disclose or suggest the use of any kind of magnetic powder. Thus, Morishita et al. '687 fail to teach a magnetic recording medium "wherein 2 to 20 times as large amounts of the magnetic layer coating material as the intended magnetic layer-wet thickness is applied" (claims 8, 17), nor of a process "wherein a solid component concentration of the magnetic layer coating material is 10% by weight or less" (claim 9, 18), nor of a "magnetic layer with a dry thickness of 0.02 to 0.08 μm " (claims 21, 23), because the limitations disclosed in Morishita et al. '687 relate to a photoconductive, not a magnetic layer. Consequently, a rejection of claims 8, 9, 17, 18, 21 or 23 would fail to meet a *prima facie* test of obviousness.

Accordingly, a *prima facie* case of obvious has not been and cannot be established. For at least the reasons above, claims 7 and 16 are therefore patentable, and withdrawal of the §103(a) rejection is therefore respectfully solicited.

Claims 8, 9, 22 and 23, being dependent upon claim 7, and claims 17-21, being dependent upon claim 16, are also allowable for the reasons above. Moreover, these claims are further distinguished by the materials recited therein, particularly within the claimed combination. Withdrawal of the §103(a) rejection is therefore respectfully solicited.

Conclusion

For the foregoing reasons, claims 7-9 and 16-23 are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of these amendments and remarks is courteously solicited. If the examiner has any comments or suggestions that would place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number below.

Dated: January 20, 2004

Respectfully submitted,

By 

David T. Nikaido

Registration No.: 22,663

Robert S. Green

Registration No.: 41,800

RADER, FISHMAN & GRAUER PLLC

1233 20th Street, N.W.

Suite 501

Washington, DC 20036

(202) 955-3750

Attorneys for Applicant

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 180013 for any such fees; and applicant(s) hereby petition for any needed extension of time.